

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 10177-169-999
CAM: 008563-999166

Group Art Unit: 3767)
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Examiner: Witczak, Catherine)
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Inventor: Robert C. Glines)
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Serial No.: 10/645,653)
)
Filed: August 20, 2003)
)
For: MEDICAL DEVICE WITH DRUG)
 DELIVERY MEMBER)
)

**PRE-APPEAL BRIEF
REQUEST FOR REVIEW**

E-FILE

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant hereby requests review of the final Office Action mailed April 11, 2007 (“Office Action”) for the above-captioned application prior to filing an appeal brief for the reasons set forth below. Applicant submits that the Office Action fails to establish that the pending claims are unpatentable. A Notice of Appeal is filed herewith.

I. PROSECUTION SUMMARY

Independent claim 25 and dependent claims 26-40 are pending. Claims 25-40 are rejected under 35 U.S.C. § 102(b) (“Section 102(b)”) as anticipated by U.S. Patent No. 5,713,853 to Clark *et al.* (“Clark”).

Independent claim 25 recites a medical device for delivering a therapeutic agent to an internal portion of a patient’s body. The medical device comprises a shaft; a self-expanding delivery member in operative communication with the shaft, in which the delivery member

has a proximal end and a distal end and being shaped in a generally continuous cylindrical configuration from a porous material capable of (i) releasing the therapeutic agent to the internal portion of the patient's body and (ii) being in a collapsed state; a therapeutic agent delivery lumen defined by a lumen wall, wherein the therapeutic agent delivery lumen is in fluid communication with the delivery member for fluidly connecting the delivery member with a therapeutic agent source; a retention member in operative communication with the delivery member, the retention member being configured and arranged to selectively collapse the delivery member; and a mechanism capable of applying negative pressure through the therapeutic agent delivery lumen to remove fluid from the delivery member.

II. FAILURE TO ESTABLISH ANTICIPATION UNDER SECTION 102(b)

Claims 25-40 are rejected under Section 102(b) as anticipated by Clark. These rejections are improper, as Clark does not disclose, teach, or suggest each and every element of independent claim 25. Independent claim 25 recites a “delivery member . . . shaped in a generally *continuous* cylindrical configuration.” (Emphasis added.) Clark does not disclose, teach, or suggest a “delivery member . . . shaped in a generally continuous cylindrical configuration.” Instead, Clark describes a catheter 700 “with an expandable distal portion which can be used for drug delivery,” wherein the distal portion “preferably comprises a *plurality of longitudinal ribs* 706 having proximal and distal ends depending from the shaft.” (Col. 13, lines 45-46, 54-57 (emphasis added).) The plurality of ribs 706 can be seen in Figures 24-25. The plurality of ribs do not form a delivery member with a “generally continuous cylindrical configuration.” Rather, as described in the specification and seen in Figures 24-25 of Clark, there are gaps between the ribs. This is intentional. Clark explains: “Blood or other fluids can flow through the region defined by the ribs 706. Thrombolytic material greater than the distance between the ribs will be caught by the ribs.” (Col. 14, lines 38-40.) Thus, Clark does not disclose, teach, or suggest each and every element of claim 25.

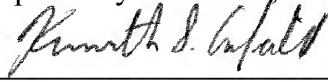
Therefore, Applicant respectfully submits that the rejection of independent claim 25 under Section 102(b) based on Clark should be withdrawn. Since claims 26-40 depend from independent claim 25, the rejection of claims 26-40 should also be withdrawn, for at least the same reasons that the rejection of claim 25 should be withdrawn.

III. CONCLUSION

It is believed that claims 25-40 are in condition for allowance. A one-month

extension fee of \$120 is believed due for this Pre-Appeal Brief Request for Review. As requested in the Notice of Appeal filed herewith, please charge this fee to Jones Day Deposit Acct. No. 50-3013. Should any additional fee(s) be due at this time, please charge such fee(s) to Jones Day Deposit Acct. No. 50-3013.

Date: August 1, 2007

Respectfully submitted,

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